

Appl. No. 10/044,059
Response filed September 21, 2005
Reply to Office Action of April 21, 2005

REMARKS

In the Final Office Action, the Examiner has rejected claims 3-6. As no amendments are made in this Response, claims 3-6 are pending.

Rejection of Claims 4 and 5 Under 35 USC § 102

The Examiner has rejected claims 4 and 5 as anticipated by Nagasawa et al., U.S. Patent No. 6,782,281. Claim 5 is a dependent claim, claiming dependency upon independent claim 4, and thus includes each and every element of claim 4.

“A claim is anticipated only if each and every element as set forth in the claim is found” in a single prior art reference. MPEP § 2131. Further, to anticipate a claim that includes the phrase “at least one of A and B,” the reference must teach at least one of A and at least one of B, and not merely at least one of A or at least one of B. See Superguide Corp. v. DirecTV Enterprises Corp. 358 F.3d 870, 886 (Fed. Cir. 2004). Likewise, this would apply to the limitation “one or more of A and B.”

Nagasawa must teach each and every element present in claims 4 and 5. However, Nagasawa does not disclose a telephone set where “the communication function unit being repeatedly operative for a predetermined time for checking the presence of one or more of an arriving call and a mail addressed to the telephone set” [emphasis added] after the telephone function stop key is pressed as recited in claims 4 and 5. Further, Nagasawa does not disclose an ICON that “comprises one or more of a telephone number of a calling party for the arriving call and a sender’s address for the mail” [emphasis added] as recited in claim 5.

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Nagasawa discloses a device that receives telephone calls and includes a pocket game machine. When the operator plays the game, the game is continuous as long as no call is received. At the time of a call, the game is suspended. Col 6, ll. 13-18. While the game is suspended, the caller's information is displayed and the user can press the call start button to begin a conversation. Col. 6, ll. 18-20. However, the user may press a start button instead of taking the call and resume the game function. Col. 6, ll. 28-36. The phone then monitors for another telephone call. Nagasawa does not disclose anything about receiving mail. Similarly, Nagasawa does not discuss an ICON that includes a caller identity and a mail address.

The device disclosed by Nagasawa is different from the device recited in claims 4 and 5. Nagasawa does not disclose a device that checks for the presence of an arriving call and a mail addressed to the telephone set. Nagasawa only monitors incoming calls and suspends game operations when a call arrives. As such, Nagasawa does not disclose all of the limitations recited in claims 4 and 5. Further, Nagasawa does not disclose an ICON comprising one or more of a telephone number and a sender's address for the mail [emphasis added] as recited in claim 5. Thus, it is respectfully requested that the rejection of claims 4 and 5 be withdrawn.

Rejection of Claim 6 Under 35 USC § 103

Claim 6 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Nagasawa in view of U.S. Patent No. 5,890,071 to Shimanuki et al. In order "to establish a *prima facie* case of obviousness of a claimed invention, all claim limitations must be taught in the prior art." MPEP 2143.03.

The cited references do not teach or suggest all of the limitations. Claim 6 depends upon claim 4 and as such includes all of the limitations of claim 4. As argued above, Nagasawa does

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not teach the following limitation: "the communication function unit being repeatedly operative for a predetermined time for checking the presence of one or more of an arriving call and a mail addressed to the telephone set." [emphasis added] These limitations are not taught by Shimanuki either.

Shimanuki discloses a radio telephone set with broadcast receiving functions and power supply switches. In particular, Shimanuki discloses power supply switches "for switching electric powers for the telephone section and the tuner section" of the telephone and radio set. Col. 3, ll. 61-67. Shimanuki teaches that the telephone section is used to receive speech signals and produce speech. Col. 4 ll. 1-17. However, Shimanuki does not teach or suggest all of the limitations of claim 6, in particular, "checking the presence of one or more of an arriving call and a mail addressed to the telephone set." [Emphasis added] Therefore, Nagasawa combined with Shimanuki does not teach or suggest all of the limitations of claim 6. Thus, it is respectfully requested that the rejection of claim 6 be withdrawn.

Rejection of Claim 3 Under 35 USC § 103

The Examiner has rejected claim 3 under 35 U.S.C. §103(a) as being unpatentable over Nagasawa in view of U.S. Patent No. 6,628,971 to Yoon et al. Again, "to establish a *prima facie* case of obviousness of a claimed invention, all claim limitations must be taught in the prior art." MPEP 2143.03. The cited references do not teach or suggest all of the limitations of claim 3, because the references do not teach or suggest the limitation of checking "whether a mail addressed to the telephone set is present on a mail server." Further, the cited references do not teach that if the mail addressed to the telephone set is present, a control means in the telephone set displays a mail ICON.

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Nagasawa, as explained above, does not teach checking "whether a mail addressed to the telephone set is present on a mail server," or displaying "a mail ICON indicative of the mail on the server." Moreover, these limitations are not taught or suggested by Yoon.

Yoon is directed to a telephone set that downloads and displays background images. In particular, after the background images have been downloaded from a computer to the mobile phone, the controller in the telephone set determines whether a user has selected a background image. If the user has selected one, the controller reads the background image from a flash memory and displays the image. Col. 3, ll. 36-65. During the time the background image is displayed, the controller monitors for an urgent or normal character message display. If the controller detects a character message, the controller stops displaying the background image and displays the normal or urgent message character. Col. 4, ll. 13-24.

However, Yoon does not disclose that the normal or urgent character image is related to mail addressed to a telephone set that resides on a server. In fact, Yoon does not teach or suggest that the system is capable of receiving mail from a server. Yoon only determines whether an urgent character message is to be displayed, and when so displayed, removes the background image.

The cited references of Nagasawa and Yoon do not teach the limitation of a control means in a portable telephone set that checks for mail. In particular, neither reference even suggests checking for mail on a server or displaying an ICON if mail is present. Therefore, it is respectfully requested that the rejection be withdrawn.

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CONCLUSION

In view of the statements set forth in this Response, it is respectfully submitted that the pending application, including claims 3-6, is in condition for allowance. Therefore, it is respectfully requested that the foregoing response be entered and the pending application be allowed.

The Examiner is invited to contact the undersigned in the event a telephone discussion would be helpful in advancing the prosecution of the present application.

Respectfully submitted,

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